

### REMARKS

The above change to claim 1 overcomes the 35 U.S.C. 112, second paragraph rejection.

Original claims 2 and 6-10 have been cancelled without prejudice. The amendment to claim 1 incorporates the subject matter of claim 2. Claim 11 adds the subject matter cancelled from claim 1. No new matter has been added nor any new issues by the amendments and the foregoing response.

Claims 1, 3, 4, 5, and 11 are pending.

#### **Drawing Objection:**

The Examiner's contention that "sensors 74, 76, 80 are shown arranged parallel to the main shaft 44 as opposed to circumferentially around the main shaft" is in error. Figure 4 shows sensor 74 arranged in a higher position than the sensor 76 thereby indicating that there is a difference in the circumferential direction. In case the sensor should be aligned in the axial direction parallel to the shaft then all sensors would be arranged on the line parallel to the axis for the main shaft. However, that is not the case in Figure 4. Thus, Figure 4 shows the claimed feature of claim 3.

Also, the specification clearly states that the sensors 74, 76 illustrated in figure 4 "are mutually displaced" in the circumferential direction of the main shaft.

Reconsideration and withdrawal of the drawing objection is respectfully requested.

**Claims 1 and 5 are patentable under 35 U.S.C. 103(a) over Irie et al (DE 3909772 A1).**

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Irie does not teach nor suggest that the reference means should be used in connection with the main shaft nor that the reference means be a direct or indirect indication of the position of the main shaft and thereby the position also of the piston. Moreover, Irie does not disclose that the sensor means is used for detecting the position of the reference means and thereby detect the angular position as well as angular speed of the main shaft.

Irie cannot render the claims of the present invention obvious at least because it fails to teach or suggest all the claim limitations. Reference is especially made to column 1, lines 66-67. No mentioning of electrical powering of the pump shaft is found. Instead, there is a disclosure for a main shaft which is driven electronically in order to provide oil in an amount and timing which is correct.

Moreover, it occurs from column 3, lines 49-56 that the system is based on a synchronous driving of the oiling plant shaft 3 and the rotation of the motor. Such special situation of driving is directly contrary to the technical effect obtained with the present invention that allows synchronized cylinder lubrication as well as a non-synchronized cylinder lubrication.

Furthermore, it is noted that the cited German publication does not mention drive means for the control shaft 3 of the pump. There is no mentioning or indication which shows that the

control shaft 3 should be driven by an AC-motor as defined in the present invention. Applicant traverses the Examiner's holding of obviousness without citing to art. Such holdings are known as taking "Official Notice" under MPEP § 2144.03. MPEP § 2144.03(A) states that "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known." (emphasis added) Driving control shaft 3 of Irie with an AC motor is not capable of instant and unquestionable demonstration as being well-known as demonstrated by the lack of any evidence of such a limitation in the record.

In addition, reference is made to column 3, lines 62. In this passage of the Office Action (bottom of Page 4), it is stated that the citation has reference means arranged on the crank shaft as well as the shaft on the lubricating apparatus for directly or indirectly detecting the mutual position of the two shafts. This point of view is incorrect. Irie mentions detectors for rotational speed of the drive shaft 3 and a detector to adjust the angle for the manual handle 2 arranged on the lubrication plant in order to adjust the shaft 29 thereof. Manual handle 2 dictates the quantity of oil supplied (Col. 3, lines 54 - 56).

Moreover, the citation also mentions a phase detector for detecting the phase of the drive shaft 3 and a detector for the angle of the motor crank shaft. There is no mentioning of the way in which these sensors function and there is no mentioning of reference means connected to the main shaft in order to indicate the position of the piston.

Irie thus does not teach or suggest all the limitations of Claim 1. Claim 5 depends from Claim 1 and shares its patentable features and adds further patentable limitations. For at least the reasons given above, the rejection of Claims 1 and 5 under 35 U.S.C. 103(a) over Irie is improper and should be withdrawn.

**Claim 3 is patentable under 35 U.S.C. 103(a) over Irie et al (DE 3909772 A1) in view of Onuma et al (US Patent 6,058,766).**

Claim 3 depends from Claim 1 and shares its patentable features and adds further patentable limitations. Onuma is a crank angle detector and does nothing to supply what is lacking in Irie. For at least the reasons given above, the rejection of Claim 3 under 35 U.S.C. 103(a) over Irie in view of Onuma is improper and should be withdrawn.

**Claim 4 is patentable under 35 U.S.C. 103(a) over Irie et al (DE 3909772 A1) in view of Onuma et al (US Patent 6,058,766), and further in view of Katogi et al. (US Patent 5,945,828).**

Claim 4 depends from Claims 1 and 2 and shares their patentable features and adds that the reference means include teeth on a toothed rim that is preferably disposed on the flywheel of the main shaft, and an index reference means, and that the sensor means include an index sensor for detecting the position of the index reference means. As the Examiner allows, Irie and Onuma do not teach or suggest these features.

Recognizing a deficiency in Irie and Onuma, the Examiner relies on Katogi as teaching a reference sensor and malfunction judging unit. However, the Examiner does not explain how those elements relate to the limitations of Claim 4. The office action does not provide any basis for the rejection of each of the features in Claim 4 and therefore applicant is unable to adequately rebut the rejections. Applicant requests clarification or withdrawal of the rejection. Katogi does not supply the elements of Claim 4, which are not taught or suggested by any reference.

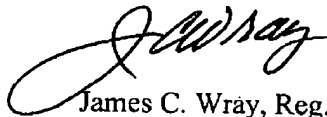
Furthermore, there would be no suggestion or motivation to combine Katogi with Irie and Onuma. Katogi is an engine combustion condition detecting apparatus and has nothing to do with lubrication. While there might be some motivation to combine Katogi with a combustion engine, there would be no motivation to combine it with a lubricating device. No advantage for such a combination can be found in the prior art.

For at least the reasons given above, the rejection of Claim 4 under 35 U.S.C. 103(a) over Irie in view of Onuma and further in view of Katogi is improper and should be withdrawn.

#### CONCLUSION

Reconsideration and notice of allowance are requested.

Respectfully,



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